

**REMARKS**

The Office action dated April 14, 2010 and the cited reference have been carefully considered.

**Status of the Claims**

Claims 1, 3-14 are pending.

Claims 12-14 are withdrawn from the present prosecution. Applicant reserves the rights to file one or more divisional applications directed to the subject matter of claims 12-14.

Claims 10 and 11 are objected to because each of them has more than one period marks. These claims have been amended to show only one period mark at the end of each claim. Therefore, this objection is now overcome.

Claims 1 and 3-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg et al. (U.S. Patent 6,579,544; hereinafter "Rosenberg"). Applicant respectfully traverses the rejection of claims 1 and 3-11 for the reasons set forth below.

**Remarks on the Examiner's Statement Regarding Foreign Priority Document**

The Examiner stated, on page 3 of the Office action dated April 14, 2010, that "Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15." Applicant is extremely puzzled as to the purpose of this statement from the Examiner because such a statement is inapposite.

37 C.F.R. § 1.55 states:

**"§ 1.55 Claim for foreign priority.**

. . .

(4)(i) An English language translation of a non-English language foreign application is not required except:

...

(B) When necessary to overcome the date of a reference relied upon by the examiner, . . ."

37 C.F.R. § 1.55 (2010).

MPEP § 201.15 states:

**“§ 201.15 Right of Priority, Overcoming a Reference**

The only times during *ex parte* prosecution that the examiner considers the merits of an applicant's claim of priority is when a reference is found with an effective date between the date of the foreign filing and the date of filing in the United States and when an interference situation is under consideration."

MPEP § 201.15 (8<sup>th</sup> Ed., Rev. 7) (emphasis added).

The only reference that has been cited by the Examiner is Rosenberg et al. (U.S. Patent 6,579,544). The effective date of this reference makes it inappropriate to cite 37 C.F.R. § 1.55 here. Withdrawal of the Examiner's statement is respectfully requested.

**Claim Rejection Under 35 U.S.C. § 103(a)**

Claims 1 and 3-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg. Applicant respectfully traverses this rejection of claims 1 and 3-11 because: (1) Rosenberg does not teach or suggest all of the limitations of each of claims 1 and 3-11; or (2) Rosenberg does not motivate a person of ordinary skill to make a composition as recited in each of claims 1 and 3-11.

**(1) Claims 1 and 3-11 Are Non-Obvious Over Rosenberg Because Rosenberg Does Not Teach or Suggest Any Composition Having All of the Limitations of Each of These Claims.**

"[O]bviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Int'l. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) (cited in MPEP § 2143.03 (8<sup>th</sup> Ed., Rev. 7)). It is not enough that each limitation of the claim is known separately in the prior art. It is error to treat the claim as a mere catalog of separate limitations, in disregard of the collective relationship of all elements set forth in the claim that gives the claim its meaning. *Structural Rubber Products Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). "The determination of obviousness is made with respect to the subject matter as a whole, not separate pieces of the claim." *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075, 1086 (Fed. Cir., 2008).

Rosenberg does not disclose any composition that comprises lutein, zeaxanthin, copper, and zinc and is free of beta-carotene. Wherever Rosenberg has lutein, zeaxanthin, copper, and zinc, he always has beta-carotene. See Rosenberg's Formulations I and II, column 23. Wherever Rosenberg does not have beta-carotene, he does not have at least one of the required components recited in each of the claims (Formulation IV does not have copper and zinc; Formulation III does not have zinc, copper, lutein, and zeaxanthin; Formulation V does not have copper, zinc, and zeaxanthin; Formulation VI does not have zeaxanthin; Formulation VIII does not have lutein). Thus, none of the eight exemplary embodiments meets the requirements of each of the present claims, and nothing in Rosenberg's specification suggests that when lutein and zeaxanthin are present, beta-carotene must be absent. Therefore, Rosenberg does not teach or suggest any composition that includes all of the limitations of each of claims 1 and 3-11.

By indiscriminately listing beta-carotene, lutein, and zeaxanthin together in a Markush group (see column 3, lines 11-12), Rosenberg clearly does not contemplate, let alone suggest, a composition that contains lutein and zeaxanthin but is devoid specifically of beta-carotene, as recited in each of the present claims. An ordinary, logical person does not suggest the absence of something by affirmatively listing it as a suitable choice. If

Rosenberg really wants to suggest the absence of beta-carotene, Rosenberg would not name it in a Markush group. There is no logical reason for the Examiner's assertion that by listing beta-carotene in a Markush group, Rosenberg suggests its absence from a composition. The Examiner must articulate a logical reason for why one would omit one (beta-carotene) but not the others (lutein and zeaxanthin). *Ex parte Whalen* (BPAI, July 23, 2008, pages 8, 12, and 13) (quoting *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (BPAI 1986)) (The Examiner may not "assert," but must set forth a reasoned, fact-based explanation supported by the evidence of record, or scientific reasoning, to establish the reasonableness of the examiner's belief.).

In contradistinction, Applicant teaches that a claimed composition is specifically free of beta-carotene. Applicant teaches that such a characteristic composition is advantageous for smokers because too much beta-carotene can be harmful to these persons. See original specification as filed, page 8. On the contrary, Rosenberg never contemplates the claimed composition (devoid of beta-carotene) because he lists lutein, zeaxanthin, and beta-carotene as among the interchangeable carotenoids for his compositions.

Applicant respectfully traverses the Examiner's statement that "the [Rosenberg's] supplement would not require the use of beta-carotene as it is disclosed in the alternative." (Office action, page 6). What is the Examiner's reason for specifically omitting beta-carotene while specifically keeping lutein and zeaxanthin in a composition? Why not other combinations (such as a composition without beta-carotene, lutein, and zeaxanthin; or one without lutein and beta-carotene; or one without beta-carotene and zeaxanthin)? Why would the Examiner pick the claimed composition if he does not reconstruct the claimed composition using hindsight?

Applicant respectfully traverses the Examiner's statement that "Rosenberg et al. does disclose the combination of lutein, zeaxanthin, copper and zinc which does not require the addition of beta-carotene." (Emphasis added). The Examiner did not cite to the specific place in Rosenberg's disclosure for this assertion, and Applicant does not find any language to suggest that. Contrary to the Examiner's assertion, Rosenberg's Formulations I-VIII never meet the claimed limitations together, as Applicant detailed above.

Moreover, the ranges of concentrations for beta-carotene, lutein, and zeaxanthin (among others) disclosed in column 17, lines 40-51 are all non-zero. This indicates that

Rosenberg never suggests a composition that has zero beta-carotene and simultaneously non-zero lutein and zeaxanthin.

In summary, since Rosenberg does not suggest any composition that has both lutein and zeaxanthin but is devoid of beta-carotene, Rosenberg does not suggest a composition as claimed in claims 1 and 3-11. Consequently, Rosenberg does not render these claims obvious.

**2) Claims 1 and 3-11 Are Non-Obvious Over Rosenberg Because Rosenberg Does Not Provide the Reason or Motivation to a Person of Ordinary Skill to Make a Composition as Recited in Each of These Claims.**

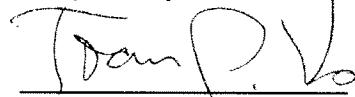
A *prima facie* case of obviousness requires that the prior art give reason or motivation to make the claimed compositions. *Esai Co. Ltd v. Dr. Reddy's Labs Ltd.*, 87 USPQ2d 1452, 1455 (Fed. Cir. 2008).

As Applicant pointed out above, Rosenberg affirmatively lists beta-carotene, lutein, and zeaxanthin together in a Markush group. The use of a Markush group is authorized to denote that the members of the groups are interchangeable and can serve the same function in the claimed overall composition, and it denotes nothing else. MPEP § 2173.05(h) (8<sup>th</sup> Ed. Rev. 7). There is no patent law precedent holding that a Markush group denotes that some members are affirmatively present while other members in the same group are absent as the Examiner asserted. The Examiner did not cite any patent law precedent for his assertion. Therefore, Rosenberg's Markush group can never mean that lutein and zeaxanthin are affirmatively present while beta-carotene is absent. Consequently, by listing beta-carotene, lutein, and zeaxanthin together in a Markush group, Rosenberg does not provide the reason or motivation to make a claimed composition that includes lutein and zeaxanthin and excludes beta-carotene.

Since Rosenberg does not provide the reason or motivation to make a claimed composition that includes lutein and zeaxanthin and excludes beta-carotene, as recited in each of claims 1 and 3-11, these claims are non-obvious over Rosenberg.

In view of the above, it is submitted that the claims are patentable and in condition for allowance. Reconsideration of the rejection is requested. Allowance of the claims at an early date is solicited.

Respectfully submitted,



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